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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,146	01/03/2002	Boris Bronfin	MM4500	7431
1109	7590	09/08/2004	EXAMINER	
ANDERSON, KILL & OLICK, P.C. 1251 AVENUE OF THE AMERICAS NEW YORK,, NY 10020-1182			IP, SIKYIN	
			ART UNIT	PAPER NUMBER
			1742	

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

AS

**Office Action Summary****Application No.**

10/038,146

**Applicant(s)**

BRONFIN ET AL.

**Examiner**

Sikyin Ip

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 June 2004.  
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,4-12,14,15,17,21,24 and 25 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 1,4-12,14,15,17,21,24 and 25 is/are rejected.  
 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All b) ☐ Some \* c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
 \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.  
 4) ☐ Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) ☐ Notice of Informal Patent Application (PTO-152)  
 6) ☐ Other: \_\_\_\_\_.

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## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 4-12, 14, 15, 17, 21, and 24-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 1, the literal support for upper-limit of beryllium content "0.0005 wt.%" cannot be found in the specification as originally filed. Moreover, said upper-limit cannot be found in Tables 1 and 4 as relied by applicants.

In claim 15, the recited properties are not supported by the specification as originally filed. Said recited properties include values that are not disclosed by the instant Table 4.

### ***Claim Objections***

Claim 17 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claim 17 is being of improper dependent form for failing to further limit the subject matter of a previous claim 2, which has been canceled.

### **Double Patenting**

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible

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harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 4-8, 11, and 14-15, 17, 21, 24, and 25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6,139,651. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed features such as Mg base alloy compositions and intermetallic compounds are overlapped by the features of said patent.

#### **Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

Claims 1, 4-6, 11-12, 14, 15, 17, 21, and 24-25 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by US 2001/0023720 to Ohori et al.

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Ohori disclose(s) the features including the claimed die-casting Mg based alloy compositions (page 2, [0031] to [0036] and Table 1, examples 17 and 24-25), mischmetal (page 4, [0071]), and creep properties (Table 3).

### **Claim Rejections - 35 USC § 103**

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1, 4-11, 13-25 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by USP 6139651 to Bronfin et al (See col. 8, Tables 1 and 2, examples 1-4 for Mg based alloy compositions and intermetallic compounds; col. 4, lines 65-67 for mischmetal; col. 5, lines 48-62 for creep properties; and col. 6, lines 47-50 for die-casting; PTO-1449).

Bronfin disclose(s) the features including the claimed Mg based alloy compositions and intermetallic compounds. The features relied upon described above can be found in the reference(s) at col. 8, Tables 1-2, examples 1-4. Therefore, it would have been obvious to one of ordinary skill in the art to select any portion of range, including the claimed range, from the broader range disclosed in a prior art reference because the prior art reference finds that the prior art composition in the entire disclosed range has a suitable utility. Also see MPEP § 2131.03 and § 2123.

Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2001/0023720 to Ohori et al. as applied to claims 1, 4-6, 11-12, 14, 15, 17, 21, and 24-25 above.

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The claimed subject matter as is disclosed and rejected above by the Ohori cited except for the intermetallic compounds. However, the instant die-casting Mg based alloy composition are overlapped by the cited reference; consequently, the properties as recited in the instant claims would have inherently possessed by the teachings of the cited reference because intermetallic compounds are material properties. Therefore, the burden is on the applicant to prove that the product of the prior art does not necessarily or inherently possess characteristics attributed to the claimed product. In re Best, 195 USPQ, 430 and MPEP § 2112.01.

"Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established, In re Best, 195 USPQ 430, 433 (CCPA 1977). 'When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.' In re Spada, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. In re Best, 195 USPQ 430, 433 (CCPA 1977)."

Claims 1, 4-6, 11-12, 14, 15, 17, 21, and 24-25 are rejected under 35 U.S.C. § 103 as being unpatentable over USP 6342180 to Lefebvre et al.

Lefebvre disclose(s) the features including the claimed Mg based alloy compositions (col. 2, lines 29-49), casting methods (col. 2, lines 54-59), and creeping properties (col. 2, lines 4-20). Therefore, it would have been obvious to one of ordinary skill in the art to select any portion of range, including the claimed range, from the broader range disclosed in a prior art reference because the prior art reference finds that the prior art composition in the entire disclosed range has a suitable utility. Also see MPEP § 2131.03 and § 2123.

Claims 1, 4-6, 9-12, 14, 15, 17, 21, and 24-25 are rejected under 35 U.S.C. § 103 as being unpatentable over EP 1127950 (PTO-1449).

Claims 1, 4-12, 14, 15, 17, 21, and 24-25 are rejected under 35 U.S.C. § 103 as being unpatentable over JP 06200348.

The references disclose the features including the claimed die-casting Mg based alloy composition (EP '950, abstract and [0035]; JP '348, abstract and [0017]). The difference between the reference(s) and the claims are as follows: cited references do not disclose the claimed intermetallic compounds as set forth in claims 8 and 10.

However, the instant die-casting Mg based alloy composition are overlapped by the cited reference; consequently, the properties as recited in the instant claims would have inherently possessed by the teachings of the cited reference because intermetallic compounds are material properties.

Therefore, the burden is on the applicant to prove that the product of the prior art does not necessarily or inherently possess characteristics attributed to the claimed product. In re Best, 195 USPQ, 430 and MPEP § 2112.01.

#### ***Response to Arguments***

Applicant's arguments filed June 7, 2004 have been fully considered but they are not persuasive.

Applicants' argument as set forth with respect to USP 6139651 is noted. But, the instant claimed 0.2 wt.% Sr and 0.0005 wt.% Be are taught by the said reference (see abstract of said reference). Moreover, the limitation, total amount of Ca and Sr at least 0.9 wt.%, is also met by said reference (see abstract).

Applicants' argument with respect to Ohori is noted. But, the instant claimed features are overlapped by the features of said reference.

Applicants argue that the alloy of Lefebvre is free of rare earth elements. But, for example, the instant claim 1 recites rare earth element as optional elements.

Applicants argue that Lefebvre fails to disclose the total amount of Ca and Sr at least 0.9 wt.%. Applicants' attention is directed to the col. 2, lines 42-49, that the total amount of CA and Sr is up to 1.1 wt.%.

Applicants' argument with respect to EP 11127950 is noted. But, the claimed Ca and Sr contents are overlapped by cited reference. Therefore, the total amount of Ca and Sr is also

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overlapped by cited reference (abstract). With respect to the instant claimed Be content which reads on zero; thus, Be is not required to disclose by cited reference.

Applicants' argument with respect to JP 06200348 is noted. But, applicants have not substantiate their position by factual evidence with declaration.

## **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The above rejection relies on the reference(s) for all the teachings expressed in the text(s) of the references and/or one of ordinary skill in the metallurgical art would have reasonably understood or implied from the text(s) of the reference(s). To emphasize certain aspect(s) of the prior art, only specific portion(s) of the text(s) have been pointed out. Each reference as a whole should be reviewed in responding to the rejection, since other sections of the same reference and/or various combination of the cited references may be relied on in future rejection(s) in view of amendment(s).

All recited limitations in the instant claims have been meet by the rejections as set forth above.

Applicant is reminded that when amendment and/or revision is required, applicant should therefore specifically point out the support for any amendments made to the disclosure. See 37 C.F.R. § 1.121.

### **Examiner Correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Ip whose telephone number is (571) 272-1241. The examiner can normally be reached on Monday to Friday from 5:30 A.M. to 2:00 P.M.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Roy V. King, can be reached on (571)-272-1244.



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The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
SIKYIN IP  
PRIMARY EXAMINER  
ART UNIT 1742

S. Ip  
September 5, 2004